



23446

PATENT TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 12917US03

In the Application of:

Daniel J. Sullivan,
 Mark D. Crockett,
 John Epler; and
 Robert A. Hilgart

U.S. Serial No.: 09/928,130**Filed:** August 10, 2001

For: COMPUTERIZED RISK
 MANAGEMENT MODULE FOR
 MEDICAL DIAGNOSIS

Examiner: Unassigned**Group Art Unit:** Unassigned**Express Mail No.** EL929181343US**Dated:** March 15, 2002

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 OFFICE OF PETITIONS

PETITION UNDER 37 CFR § 1.47(a)

The applicants respectfully petition the Director, under 37 CFR § 1.47(a), to accept the enclosed Combined Declaration and Power of Attorney and allow prosecution of this application to proceed.

The present application names four joint inventors – Daniel J. Sullivan, Mark D. Crockett, John Epler, and Robert A. Hilgart. Inventors Crockett, Epler, and Hilgart have executed the enclosed Combined Declaration and Power of Attorney.

Inventor Sullivan has refused to execute the enclosed Combined Declaration and Power of Attorney. The enclosed Combined Declaration and Power of Attorney has been executed on behalf of inventor Daniel J. Sullivan by John Epler, a joint inventor.

The circumstances attending Inventor Sullivan's refusal to execute the enclosed Combined Declaration and Power of Attorney are provided in the attached Declaration of Attorney George Wheeler.

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The last known address of Daniel J. Sullivan is:

210 St. Michael's Court
Oakbrook, IL 60523

The fee for this petition is understood to be \$130.00. 37 CFR § 1.17(h). A check for this sum is enclosed. Please credit any excess or charge any additional fee presently required to Deposit Account 13-0017.

Respectfully submitted,

By: 
George Wheeler
Reg. No. 28,766
Attorney for applicant(s)

March 15, 2002
DATE

McAndrews, Held & Malloy, Ltd.
34th Floor
500 West Madison Street
Chicago, IL 60661
312/775-8000



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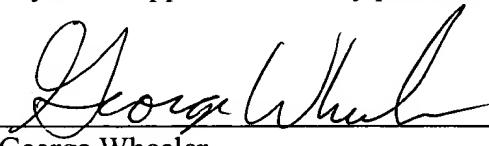
Dated: March 15, 2002

DECLARATION OF ATTORNEY GEORGE WHEELER
SUPPORTING COMPLETION OF FILING REQUIREMENTS

I, George Wheeler hereby declare that the present patent application, as identified above in the caption, is the application which the inventor(s) executed on March 11, 2002, and March 13, 2002 by signing the Combined Declaration and Power of Attorney In Original Application enclosed herewith.

All statements made herein of my own knowledge are true, and all statements made herein on information and belief are believed to be true. I have been warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18 U.S. Code 1001, and may jeopardize the validity of the application or any patent issuing thereon.

March 15, 2002
Date


George Wheeler
Reg. No. 28,766

George Wheeler

From: mshaftal@pfs-law.com
Sent: Thursday, March 14, 2002 11:34 PM
To: George Wheeler
Cc: sulyvan@aol.com; sharris@hkgold.com
Subject: RE: IBEX patent application -- 6-month deadline to file Sullivan's Oath is March 18, 2002



George:

Dan Sullivan has indicated to me that without admission, waiver or prejudice, he is willing to sign a Declaration that does not give power of attorney to Ibex patent counsel and that deletes any mention of or reference to any other purported co-inventors. We had previously indicated his willingness to do so. Please let us know if this is acceptable to Ibex. Thanks,

Max Max Shaftal

PATZIK, FRANK & SAMOTNY LTD.

150 South Wacker Drive, Suite 900

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From: gwheeler@mhmlaw.com [mailto:gwheeler@mhmlaw.com]

Sent: Tuesday, March 12, 2002 3:38 PM

To: mshaftal@shaftal.com

Cc: jlebow@ibex-systems.com; EMAS@mhmlaw.com

Subject: IBEX patent application -- 6-month deadline to file Sullivan's Oath is March 18, 2002

VIA MESSENGER; COPY BY E-MAIL

Max Shaftal
Law Offices of Shaftal and Associates, Ltd.
Suite 3000
300 South Wacker Drive
Chicago, IL 60606

RE: U.S. Patent Application
COMPUTERIZED RISK MANAGEMENT MODULE
DIAGNOSIS

Serial No. 09/928,130
Our File No. 12917US03

FOR MEDICAL

Dear Max:

You will recall that Dr. Sullivan has not yet executed the patent application identified above, which we forwarded in November, 2001. The original deadline set in the "NOTICE TO FILE MISSING PARTS OF APPLICATION -- FILING DATE GRANTED" for filing an executed oath was November 18, 2001. We therefore have the opportunity to file the executed oath by March 18, if accompanied by a four-month extension of time and the appropriate government fee of \$720.

We enclose: * a copy of a "NOTICE TO FILE MISSING PARTS OF APPLICATION -- FILING DATE GRANTED.;"
* a copy of the patent application and accompanying drawings as originally filed; and
* two copies of a COMBINED DECLARATION AND POWER OF ATTORNEY.

We ask that you forward the enclosures to Dr. Sullivan and find out whether he is willing to sign the declaration (which is not accompanied by an assignment, pending further negotiations). To facilitate his review, we are also e-mailing this letter and enclosures to you. If Dr. Sullivan is willing to sign the Combined Declaration, please have him sign and date it and return it to us no later than the morning of Monday, March 18. (Note that I will be out of the office March 18, though I can be reached at 312-775-8000, Extension 8115, for most of Saturday, March 16.) We will then forward it to the U.S. Patent and Trademark Office. If Dr. Sullivan is unwilling to sign the declaration, please let us know no later than the end of the day on Thursday, March 14, if possible, so we can have one of the co-inventors sign the application on his behalf and prepare the necessary declaration showing our efforts to obtain Dr. Sullivan's signature.

Very truly yours,

George Wheeler

GW/liz

Enclosures

Cc: Joan S. Lebow, Esq. Edward A. Mas II

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34th Floor
500 W. Madison Street
Chicago, IL 60661
voice: 312-775-8000
voice mail: 312-775-8200, ext. 8115
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George Wheeler
gwheeler@mhmlaw.com

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DECLARATION OF GEORGE WHEELER

I, George Wheeler, declare the following:

1. I am an attorney of record in this application. I have been directly involved in preparing and prosecuting the present patent application. I am making this declaration to show facts in support of a petition, under 37 CFR § 1.47(a), requesting the Director to accept the enclosed Combined Declaration and Power of Attorney ("Oath"), executed on behalf of inventor Daniel J. Sullivan by a joint inventor.

2. On information and belief, the present application properly names four joint inventors – Daniel J. Sullivan, Mark D. Crockett, John Epler, and Robert A. Hilgart. Inventors Crockett, Epler, and Hilgart have executed the enclosed Oath.

3. Inventor Sullivan has refused to execute the enclosed Oath, on the basis that he regards himself to be the sole inventor. Dr. Sullivan is represented respecting this dispute by Attorney Max Shaftal, of Patzik, Frank & Samotny Ltd.; Suite 900; 150 South Wacker Drive; Chicago, Illinois 60606.

4. The undersigned filed a provisional patent application, to which the present application claims priority, on October 31, 2000, as U.S. Serial No. 60/244,496, naming the same four joint inventors named in the present application, including Dr. Sullivan. Materials provided by Dr. Sullivan and other input provided by the other three inventors were used to prepare the provisional patent application.

5. The undersigned believes that he first became aware that Dr. Sullivan was claiming sole inventorship of all the claims in the present application in late October or early November, 2000, about or shortly after the time the undersigned filed U.S. Serial No. 60/244,496. When a draft of the application was forwarded to Dr. Sullivan, he indicated that, in his view, the subject matter claimed in the application was his sole invention. Dr. Sullivan communicated this to the undersigned when the undersigned forwarded a draft patent application, including claims, to Dr. Sullivan to get his input before filing a non-provisional patent application.

6. On information and belief, Dr. Sullivan filed his own provisional patent application on similar subject matter, Serial No. 60/245,255, on November 2, 2000, naming himself as the sole inventor. The undersigned does not know whether Dr. Sullivan filed a non-provisional patent application respecting the subject matter of Serial No. 60/245,255.

7. The undersigned filed the parent of the present application, Non-Provisional Application Serial No. 09/705,058, on November 2, 2000, without the inventors' signatures. Serial No. 09/705,058 claimed the priority of U.S. Serial No. 60/244,496. The undersigned later forwarded an Oath for Serial No. 09/705,058 to the proposed assignee, requesting execution by all four inventors. On information and belief, Dr. Sullivan refused to execute the Oath when it was forwarded to him by the proposed assignee.

8. On July 12, 2001, the undersigned contacted Mr. Shaftal to seek Dr. Sullivan's signature on the Oath. On information and belief, Mr. Shaftal stated that his client, Dr. Sullivan, still regarded himself as the sole inventor.

9. On July 31, 2001, the undersigned called Mr. Shaftal on the telephone to arrange a meeting to discuss the issue of inventorship. On August 7, 2001, the undersigned met with Mr. Shaftal to discuss the issue of inventorship. The issue was not resolved, and Mr. Shaftal indicated that Dr. Sullivan still regarded himself to be the sole inventor.

10. On August 10, 2001, the undersigned filed the present application, Serial No. 09/928,130, and claimed priority to and paid the retention fee and necessary extension of time fees for Application Serial No. 09/705,058.

11. The USPTO mailed a Notice of Missing Parts in this application on September 18, 2001.

12. On November 6, 2001, Attorney Edward Mas, a partner of the undersigned, mailed the specification and Oath for the present application to Mr. Shaftal, along with a letter requesting that Mr. Shaftal have his client, Dr. Sullivan, either execute the application, as a joint inventor, or indicate if he would not execute a joint application. Dr. Sullivan did not sign the Oath.

14. The undersigned followed up on this matter several times during December, 2001, and January and February, 2002. The Oath was not signed as a result.

15. On March 12, 2002, the undersigned again sent the application papers, including the Oath naming the four co-inventors identified above, to Mr. Shaftal for signature by Dr. Sullivan, and advised that the extended deadline for filing the signed Oath, after obtaining a four-month extension of time, would be March 18, 2002.

16. On March 14, Mr. Shaftal sent an e-mail response to the undersigned, stating that Dr. Sullivan would sign the Oath if he were designated as the sole inventor. A paper copy of this e-mail is attached as Exhibit A. This condition is unacceptable to the other inventors because, based on the investigation by the undersigned and the other inventors' understanding, Dr. Sullivan is not the sole inventor.

17. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date March 15, 2002


George Wheeler
Reg. No. 28,766